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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,377	08/28/2000	Sergey Matasov		9553

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EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/09/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/509,377

Applicant(s)

MATASOV, SERGEY

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

### ***Priority***

2. Applicant's claim for priority to August 21, 1978 is not in compliance with 35 U.S.C. 119(d). The right of priority to an inventor's certificate is subject to the same conditions and requirements as apply to applications for patents under 35 U.S.C. 119. Particularly, Applicant could obtain the benefit of the earlier filing date of the inventor's certificate *if the application in this country is filed within twelve months from the earliest date on which such inventor's certificate was filed* (see 35 U.S.C. 119(a)). Currently, Applicant's priority date only extends back to October 3, 1997.

35 U.S.C. 119(a) also states that "no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country".

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Accordingly, Applicant's inventor's certificate, which was published on July 15, 1989, is prior art with respect to this application.

### *Drawings*

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on February 13, 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### *Specification*

4. The disclosure is objected to because of the following informalities:

a) The specification is objected to due to grammatical and idiomatic errors. Such errors make the specification difficult to read and confusing at times. Please note that the sentence on page 4, line 2 mentioned in the previous Office Action still appears to be incomplete (i.e., ends in a comma). In addition, the newly added sentences on page 3 (note first item in the amendments to the specification of the response filed 2/13/03) are indefinite as to meaning.

b) The specification has been amended to contain new matter. The paragraph inserted at page 3, line 12 (note first item in the amendments to the specification of the response filed 2/13/03) and page 5, line 1 (note second item in the amendments to the specification of the response filed 2/13/03) apparently describes that the working pressure is applied to gap 25. This subject matter was not in the specification as originally filed.

Appropriate correction is required.

*Claim Objections*

5. Claims 1-3, 5, 7, 8, 10, 16 and 17 are objected to because of the following informalities:

As to claim 1, "an invaginator of a thin-walled tube" appears to be claiming two separate elements yet, according the specification, the invaginator is a thin-walled tube. Suggested: --an invaginator made of a thin-walled tube--.

As to claim 2, "formed in a hollow cylinder" appears to be claiming an additional element (hollow cylinder). Suggested: --formed into a hollow cylinder--.

As to claim 3, "said gap is keeping under" should be --said gap is kept under--. In addition, --the-- or --said-- should be inserted before "invaginator".

As to claim 5, "shell of invaginator" should be --shell of said invaginator--.

As to claim 7, line 1, "of endoscopic tube" should be --of an endoscopic tube--; lines 3, 4 and 6, "of endoscopic tube" should be --of the endoscopic tube--; line 2, "an invaginator of a thin-walled tube" should be --an invaginator made of a thin-walled tube--; line 5, "shell of invaginator" should be --shell of said invaginator--.

As to claim 8, --the-- or --said-- should be inserted before "invaginator".

As to claim 10, --the-- or --said-- should be inserted before "invaginator".

As to claims 16 and 17, line 1, "a" should be removed before "distal drives".

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 3 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 3 and 8 recite that the gap (referring to gap 25) is kept under working pressure. The original specification fails to disclose this. Instead, the original specification describes that working pressure is applied to cavity 14 and that cavity 14 and gap 25 are separated by seal (29) (page 5 of specification).

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 3, 8, 13 and 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 3, the term "working pressure" lacks antecedent basis. In addition, it is not clear as to what "cavity of invaginator" is referring.

As to claim 8, the term "working pressure" lacks antecedent basis. In addition, it is not clear as to what "cavity of invaginator" is referring.

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As to claims 13 and 15, the term "a channel in the cavity of intestines" is indefinite. Portions of the human body can not be positively claimed as a claim element.

As to claims 16 and 17, an endoscopic tube has previously been recited, making the phrase "further comprising an endoscopic tube" redundantly recite an endoscopic tube.

Suggested: --The endoscope according to any of claims 1,2,3,7,8 wherein the endoscopic tube comprises...--.

As to claim 18, term "piston of biopsy channel" is indefinite.

As to claim 19, term "distal drive of cutters" is indefinite.

### *Claim Rejections - 35 USC § 102*

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 4-7, 9-12, 14 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Matasov (SU Inventors Certificate No. 1522466).

The inventor's certificate discloses an endoscope tube (3), comprising an invaginator (4) which forms a pleated hollow cylinder around the distal part of the endoscopic tube (note Figure). Inherently, there is a gap between the invaginator and the endoscope tube and the endoscope tube is sealed on its distal end. A shell/anal dilator (19) is provided for insertion into the rectum. The endoscope tube (3) inherently comprises a outer protective tube which meets the

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limitation of a preservative. Note proximal seal (13) and spring (10). Inherently, the endoscopic tube as a tip comprising a protective glass (the very nature of viewing by the endoscope dictates a protective glass, whether it be a plate or a lens). As to claim 20, the shape of a cylinder/piston unit is cylindrical. Note cylindrical shape of tube (4) in the Figure.

12. Claims 1-9, 11, 12 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bob et al. (U.S. Pat. 5,259,364).

Bob et al. disclose an invaginator (24) and an endoscope tube (2). As shown in Figure 2, the invaginator (24) would be gathered on the distal end (as the endoscope tube enters the anus 30) by pleats (52) (col. 5, lines 7-9). As to claims 2, 3 and 8, pleats (52) form a compact hollow cylinder which defines a gap (note space between pleats and endoscope tube in Figure 2) that is maintained under working pressure (col. 5, lines 18-22). As to claim 4, the distal end (38) of the endoscope tube encloses a camera and is thus inherently sealed. As to claim 5, note shell (50). As to claims 6 and 7, the endoscope tube (2) inherently comprises an outer protective sheath which meets the limitation of a preservative. As to claim 9, note seal (58). As to claim 11, note tip (38). As to claim 12, a protective glass is inherent since a camera for viewing is located in the tip (38). As to claim 20, the invaginator (24) is cylindrical (i.e., shape of a cylinder/piston unit).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matasov (SU 1522466) in view of Wilk et al. (U.S. Pat. 5,396,879) and further as being unpatentable over Bob et al. in view of Wilk et al.

Matasov discloses a bendable distal portion (indicated by the bending control knob on control block 2) but fails to disclose the particulars of the bending mechanism. Since any bending mechanism could be used in the endoscope of Matasov without any effect of the operation of the disclosed device, it would have been obvious to one of ordinary skill in the art to have provided any known bending mechanism in the Matasov endoscope. Wilk et al. disclose a bending mechanism that incorporates solenoids or hydraulic mechanisms in the distal end of the endoscope for the purpose of bending (note Figure 1 and col.3, lines 47-53). At least the solenoid would meet the limitation of "made in the shape of cylinder/piston units" since a solenoid would comprise a plunger within a cylinder.

Bob et al. discloses that the everting tube mechanism is "suited for all kinds of endoscopes" but fails to provide all the particulars of the endoscope, and particularly that the endoscope includes a distal bending drive made in the shape of cylinder/piston units. Since any endoscope could be used in the invention of Bob et al. and endoscopes with the particular bending mechanism as claimed are known, it would have been obvious to one of ordinary skill in the art to have used an endoscope having a bending mechanism as taught by Wilk et al. (note discussion above).

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15. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matasov (SU 1522466) in view of Hake (U.S. Pat. 4,893,613) and further as being unpatentable over Bob et al. in view of Hake.

Hake disclose distal bending drives in the shape of "sylphon" (23, Fig.5) (note Applicant has defined this term in page 2 of paper number 8. The definition appears to be describing a expandable bellows). For the reasons set forth in the preceding numbered paragraph (14), it would have been obvious to have provided the known "sylphon" shaped drive in the endoscope of Matasov and Bob et al.

#### ***Response to Arguments***

16. Applicant's arguments filed February 13, 2003 have been fully considered but they are not persuasive. Although much of Applicant's remarks could not be understood as to their intended meaning, it is apparent that Applicant relies heavily on *disclosed* subject matter instead of what is being broadly claimed to rebut the Examiner's position. This is where a registered patent attorney or agent would be helpful.

The Examiner has more clearly tried to set forth his position in the Office Action appearing above.

#### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

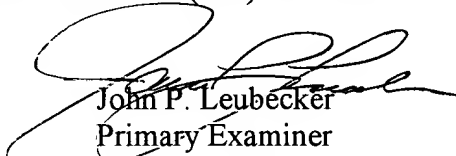
Adair (U.S. Pat. 5,643,175)--note Figure 12.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl  
May 29, 2003